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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,508	04/27/2001	Alan P. Wolffe	8325-0014	9058

20855 7590 11/19/2002

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EXAMINER

SANDALS, WILLIAM O

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 11/19/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/844,508

Applicant(s)
Wolffe et al.

Examiner
William Sandals

Art Unit
1636



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 16, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-72 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. The previous restriction is deemed to be in error. As a result, a new grounds for restriction is presented below.
2. Claim 1 links inventions I and II-VI. The restriction requirement regarding the linked inventions is subject to the nonallowance of the linking claim 1. Upon the allowance of the linking claim, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claim will be entitled to examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable linking claim is presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.
3. Claim 34 links inventions VII and VIII. The restriction requirement regarding the linked inventions is subject to the nonallowance of the linking claim 34. Upon the allowance of the linking claim, the restriction requirement as to the linked inventions shall be withdrawn and any

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claims depending from or otherwise including all the limitations of the allowable linking claim will be entitled to examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable linking claim is presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Election/Restriction

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, 8, 10-13, 17-33 and 43-70, drawn to a method for modifying cellular chromatin with a fusion molecule comprising a chromatin remodelling complex and a DNA binding domain, classified in class 435, subclass 183.
 - II. Claims 1, 15, 40 and 71, drawn to a polynucleotide and a method of expressing a fusion polypeptide, classified in class 435, subclass 69.7.
 - III. Claims 1 and 7, drawn to a method for modifying cellular chromatin with a fusion molecule comprising a chromatin remodelling complex and a DNA binding domain, wherein the DNA binding domain is a triplex forming nucleic acid, classified in class 435, subclass 455.

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- IV. Claims 1 and 9, drawn to a method for modifying cellular chromatin with a fusion molecule comprising a chromatin remodelling complex and a DNA binding domain, wherein the remodelling complex is non enzymatic, classified in class 435, subclass 4.
- V. Claims 1 and 14, drawn to a method for modifying cellular chromatin with a fusion molecule comprising a chromatin remodelling complex and a DNA binding domain, wherein the chromatin remodelling complex facilitates recombination between an exogenous nucleic acid and cellular chromatin, classified in class 435, subclass 440.
- VI. Claims 1 and 16, drawn to a binding site assay, classified in class 436, subclass 501.
- VII. Claims 34-37, 39 and 41, drawn to a fusion polypeptide and a cell comprising the polypeptide, classified in class 530, subclass 350.
- VIII. Claims 34 and 38, drawn to a non enzymatic fusion polypeptide, classified in class 530, subclass 358.
- IX. Claims 40 and 42, drawn to a nucleic acid encoding a fusion polypeptide and a cell comprising the nucleic acid, classified in class 536, subclass 23.1.
- X. Claim 72, drawn to a method of introducing an exogenous molecule into a cell, classified in class 514, subclass 2.

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5. The inventions are distinct, each from the other because of the following reasons:

6. Inventions of Groups I-IV are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Groups I-VI and X comprise steps which are not required for or present in the methods of the other groups: The use of an enzymatic remodelling complex (Group I), expressing a nucleic acid (Group II), formation of a triplex nucleic acid DNA-binding domain (Group III), use of a non-enzymatic remodelling complex (Group IV), a method of recombination (Group V), a method of a binding assay (Group VI), and method of introducing (Group X). The end result of the methods are different and thus the operation, function and effects of these different methods are different and distinct from each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

7. Inventions of Groups I-VI & X and Groups VII-IX are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Groups I-VI & X comprise steps which do not require the compositions of Groups VII-IX. The operation, function and effects of the polypeptide of Group VII, the non-enzymatic polypeptide of Group VIII and the nucleic acid of Group IX are completely different and distinct from the operation, function and effects of the methods of modifying of Group I, method of expression of Group II, method of triplex formation of Group III, method of non-enzymatic

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modification of Group IV, method of recombination of Group IV, method of binding assay of Group V and method of introducing of Group X. Therefore, the inventions of these different and distinct groups are capable of supporting separate patents.

8. The polypeptide of Group VII, the non-enzymatic polypeptide of Group VIII and the nucleic acid of Group IX are each structurally, biochemically and functionally distinct from each other and thus one does not render the other obvious. The polypeptide of Group VII is functionally distinct from the non-enzymatic polypeptide of Group VIII, and the nucleic acid of Group IX is not required to produce the polypeptides of Groups VII and VIII (the polypeptides may be produced synthetically or isolated from cells). Further, the polypeptides of Groups VII and VIII are not required to produce the nucleic acid of Group IX. Therefore the inventions of the three groups are distinct and are capable of supporting separate patents.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

12. Certain papers related to this application are *welcomed* to be submitted to Art Unit 1636 by facsimile transmission. The FAX numbers are (703) 308-4242 and 305-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by the applicant or applicant's representative, and the FAX receipt from your FAX machine is proof of delivery. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications should be directed to Dr. William Sandals whose telephone number is (703) 305-1982. The examiner normally can be reached Monday through Thursday from 8:30 AM to 7:00 PM, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached at (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to the William Phillips, whose telephone number is (703) 305-3482.

William Sandals, Ph.D.
Examiner
November 4, 2002


TERRY MCKELVEY
PRIMARY EXAMINER